

### **REMARKS**

Prior to entry of this paper, Claims 1-29 were pending. Claims 1-29 were rejected. In this paper, Claims 1, 5, 9, 16, 18, and 22 are amended; no claims are cancelled or added. Claims 1-29 are currently pending. No new matter is added by way of this amendment. For at least the following reasons, Applicants respectfully submit that each of the presently pending claims is in condition for allowance.

### **Claim Rejections – 35 U.S.C. § 102**

Claims 9-12 and 15 are rejected under 35 U.S.C. 102 (e) as being anticipated by Harms et al (US 2003/0078981). Applicants respectfully traverse this rejection. The rejection to amended Claim 9 is respectfully traversed at least because Harms fails to disclose, “accessing, over a network, an electronic archive comprising a list of e-mail addresses generated with a first application”, in conjunction with “parsing, over the network, the electronic archive for the e-mail addresses” as claimed in part, by at least Applicants’ amended Claim 9.

Applicants maintain that Harms does not teach or suggest accessing, over a network, an electronic archive. “Monitoring incoming message” (see Harms, Figure 2, element 210) is not accessing *an electronic archive* comprising a list of emails. While the messages may come from an electronic archive (which the Applicants deny; messages typically are received from an individual sender, not an archive), Harms teaches receiving an email message sent to a user. This is different than accessing an electronic archive comprising a list of e-mail addresses. Further, it is respectfully submitted that Harms merely accesses the message received in this case, not an electronic archive comprising a list of e-mail addresses. The server sending the email might have an electronic archive, but if so, Harms does not have access to that electronic archive; Harms accesses the received email.

In addition, Applicants hold that Harms does not teach or suggest parsing, over the network, the electronic archive for the e-mail addresses. As shown above, Harms does not appear to have access to the source of the incoming messages. Therefore, Harms does not have the ability to



discuss the differences between these two entities nor describe how an address book is not suitable for Tafoya's invention.

Claim 21 is respectfully submitted to be allowable for at least the reasons stated above. Claims 22-27 are respectfully submitted to be allowable at least because they depend from Claim 21.

Additionally, the rejection to amended Claim 22 is respectfully traversed for at least the following additional reasons. It is respectfully submitted that Tafoya fails to disclose, "adding the e-mail address to the electronic address book further comprises adding the e-mail address if the e-mail address occurs at a certain frequency, wherein the e-mail address is automatically excluded if the e-mail address occurs below the certain frequency, the e-mail address is similar to another e-mail address, or a date associated with the e-mail address meets a threshold", as recited, in part, at least by Applicants' amended Claim 22.

For example, Tafoya discusses at column 12, lines 20-30 that send/receive usage, send frequency, and receive frequency may be used to assign a weight to each entry in the resolution list (based on an equation shown in box 422 of FIG. 4B of Tafoya). In one embodiment of the Applicants' invention, a user may select a number N, and any email address with a frequency less than N is automatically excluded from the address book, or select a date in which emails not appearing after that date are automatically excluded from the address book. In contrast, with Tafoya, frequency is a factor that is weighted, but Tafoya fails to disclose a particular minimum frequency for which it is guaranteed that the email will not be included. Rather, in Tafoya, frequency is one factor that weighted. Therefore, Applicants suggest that the rejection of amended Claim 22 is moot and should be withdrawn.

Claims 28-29 are rejected under 35 U.S.C. 102 (e) as being anticipated by Creswell et al. (US 6,564,264). Applicants respectfully traverse this rejection. The rejection to Claim 28 is respectfully traversed at least because Creswell fails to disclose, "accessing a first source electronic address book for a first e-mail address", as recited, in part, at least by Applicants' Claim 28.

Creswell describes updating a user's address book, starting with addresses from incoming and outgoing messages. In Creswell, the **destination** is an address book in this case, but the **source** is not an electronic address book. Creswell does not appear to teach or suggest that the first e-mail address be accessed from a first electronic address book. Instead, Creswell teaches **"monitoring a user's outgoing and incoming messages** to determine if the sender or recipient address is correct, and, if not, automatically locating the correct address by accessing internal directories and/or on-line directories." See Creswell, column 2, lines 12-15. Here, Creswell appears to teach that the first e-mail address is accessed from outgoing or incoming messages, **not** from an electronic address book. Once the first e-mail address is accessed, **then** the address is located in an internal and/or on-line directory. Accessing the first e-mail address from a **message** is not the same as accessing the first e-mail address from an electronic address book. For at least this reason, Creswell does not teach nor render obvious at least Claim 28. Claim 28 is respectfully submitted to be allowable at least for at least the reasons stated above. Claim 29 is respectfully submitted to be allowable at least because it depends from Claim 28.

Claims 1, 16, and 18 are rejected under 35 U.S.C. 102 (b) as being anticipated by Huang et al. (US 5,966,714). Applicants respectfully traverse this rejection. Further, Applicants assume the inclusion of this rejection is an oversight since these claims are additionally rejected under 35 U.S.C. 103 (a) as being unpatentable over Harms et al. (US 2003/0078981) in view of Huang et al. (US 5,966,714).

### Claim Rejections – 35 U.S.C. § 103

Claims 1-6, 8, 13, and 16-20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Harms et al. (US 2003/0078981) in view of Huang et al. (US 5,966,714). Claim 7 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Harms et al. (US 2003/0078981) and Huang et al. (US 5,966,714) as applied to claim 1 above, and further in view of Creswell et al. (US 6,564,264). Claim 14 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Harms et al. (US 2003/0078981) as applied to claim 12 above, and further in view of Montville et al. (US 6,356,937). Applicants respectfully traverse these rejections.

Applicants hold that neither Harms nor Huang, either alone or in combination, teach or suggest searching, over a network, through at least one archive of emails, as claimed, in part, by at least amended Claim 1. As shown above with respect to amended Claim 9, Harms does not appear to have access to the source of the incoming messages. Therefore, Harms does not have the ability to search through the source of the incoming messages for e-mail addresses, over the network. Instead, Harms teaches “monitoring and scanning messages in an email inbox to retrieve display names and simple mail transfer protocol (SMTP) addresses of senders and/or recipients of each email.” See Harms, paragraph 0007. Assuming the source of the incoming messages in Harms is the archive of e-mails (which the Applicants deny), Harms does not teach searching, **over the network**, the archive. Therefore, Harms does not teach or suggest this limitation of amended Claim 1. Further, Huang does not cure this defect. Therefore, neither Harms nor Huang, either alone or in combination, render obvious at least amended Claim 1.

Further, amended Claims 16 and 18 have been amended to recite similar, albeit different, limitations to amended Claim 1. Therefore, amended Claims 16 and 18 should be allowable for substantially similar reasons as amended Claim 1.

Furthermore, dependent Claims 2-8, 13-14, and 16-20 depend from Claims 1, 9, 18, and 23 respectively, and are patentable for at least the same reasons as the independent claims from which the dependent claims depend. Accordingly, the dependent claims should be allowable at least for the same reasons as for their parent Claims.

The rejection to amended Claim 5 is also respectfully traversed at least because the proposed combination fails to meet the further limitations of amended Claim 5 considered as a whole. Amended Claim 5 recites, “determining if the at least one archive from which the e-mail address was retrieved includes an organization; organizing the electronic address book according to an organization of at least a portion of the at least one archive from which the e-mail address was retrieved; and the adding includes adding the e-mail such that the e-mail address is added according to the organized address book.”

The fact that the names in Figure 4 of Harms are listed in alphabetic order may have been coincidental, as the natural order occurring in the mind the drafter of the Harms document, rather than organization performed by the method of Harms. However, even if the method of Harms did perform an alphabetizing step that is not mentioned in the patent, this would be independent of the organization of the source. For example, Harms does not disclose determining whether the database is alphabetized, and if so, alphabetizing the destination list accordingly. Rather, the alphabetizing step performed in Harms, if there is one, is independent of any organization that exists in the source. Applicants' amended Claim 5 includes a determination whether the source archive includes an organization, and if so, organizing the electronic address book in accordance with the organization of the source. In one embodiment of Applicants' invention, the determination of organization is a determination of whether the source is organized by folder, although the invention is not so limited. Organization by alphabetizing is included within the scope of amended Claim 5. However, Harms does not disclose a step of determining whether the source archive is alphabetized. The proposed combination fails to meet the limitations of Applicants' amended Claim 5. As such, Applicants hold that the rejection of amended Claim 5 is now moot and should be withdrawn.

**CONCLUSION**

It is respectfully submitted that each of the presently pending claims (Claims 1-29) is in condition for allowance and notification to that effect is requested. Examiner is invited to contact the Applicants' representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby. Although only certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentable. Applicants reserve the right to raise these arguments in the future.

Dated: May 7, 2007

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